

ESTTA Tracking number: **ESTTA174773**

Filing date: **11/14/2007**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

| | |
|---------------------------|--|
| Proceeding | 91179259 |
| Party | Defendant Daniel, Sayo Isaac |
| Correspondence Address | SANFORD J. ASMAN LAW OFFICE OF SANFORD J. ASMAN 570 VININGTON CT ATLANTA, GA 30350-5710 UNITED STATES sandy@asman.com |
| Submission | Other Motions/Papers |
| Filer's Name | Sanford J. Asman |
| Filer's e-mail | sandy@asman.com |
| Signature | /sanford j. asman/ |
| Date | 11/14/2007 |
| Attachments | 071114_Motion_and_Answer.pdf (8 pages)(49750 bytes) |

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

ID SOFTWARE, INC.,

Plaintiff-Opposer

v.

SAYO ISAAC DANIEL

Defendant-Applicant.

Opposition No. 91179259

MOTION TO DISCHARGE ORDER TO SHOW CAUSE

COMES NOW, Sayo Isaac Daniel, Defendant-Applicant (“Applicant”), by his undersigned attorney, and shows the TTAB as follows:

Statement of Relevant Facts

The Answer in the present Opposition was due by October 9, 2007, but it was not timely filed. The circumstances which resulted in that failure were that undersigned, a sole practitioner, had a computer failure apparently brought on by a virus introduced to undersigned’s system in an attachment to a client’s email. The computer failure, which occurred between September 28, 2007 and October 2, 2007, happened at an extremely critical time in that undersigned had a trial in Atlanta, Georgia on September 28, 2007¹; to be followed by a hearing in U.S. District Court in Green Bay, Wisconsin on October 4, 2007²; and a trial in U.S. District Court in Atlanta, Georgia on October 9, 2007³, all of which were prior to the answer due date, or immediately thereafter, such that these matters impaired undersigned’s ability to restore the system. Further, while

¹ A *pro bono* matter in the Atlanta Municipal Court, *State v. Blake Adams*.

² A Summary Judgment hearing before the Hon. William C. Griesbach, in *WS PackagingGroup, Inc. v. Global Commerce Group, LLC*, Civil Action No. 1:06-cv-00674-WCG.

undersigned was engaged in recovering data from the system, undersigned was confronted with having to respond to an Emergency Application in U.S. District Court in Trenton, New Jersey on October 11, 2007⁴.

The virus which completely disabled undersigned's primary office computer, on which the docketing system runs, ultimately required that undersigned's computer system be completely reformatted and restored from backups. As set forth above, the virus was introduced to undersigned's system, at a time when undersigned's primary obligations were to the forthcoming hearing in U.S. District Court in Green Bay and the forthcoming trial in U.S. District Court in Atlanta. Consequently, the focus at that time was to recover the data on the system and to avoid losing any data required for either of those immediately forthcoming court dates.

Upon the completion of those matters, undersigned began the restoration of the system, and was met with the foregoing Emergency Application which required an immediate response. Consequently, it was several days later that the restoration of undersigned's system was completed. During the foregoing time, undersigned's docketing system was unavailable, and the due date for the required Answer in the present Opposition passed without the filing of an Answer.

Upon being notified of the TTAB's Order to Show Cause, undersigned phoned the Interlocutory Attorney, Ms. Elizabeth Winter, who was apparently out of the office for several days due to an illness. Upon speaking with Mr. Winter, today, the procedure for filing the present motion and accompanying Answer were discussed.

With respect to the application to register Applicant's mark, "ID PHONE" in IC 009, a number of things should be pointed out, as well. Firstly, the Opposer did not object to the

³ A trademark infringement action before the Hon. Clarence Cooper, Jr., in *Big Oak Golf Design, Inc. v. De Ubago et al.*, Civil Action No. 1:04-CV-2584-CC.

registration of the mark by Applicant.⁵ Nor did the Opposer object to the registration of the mark in IC 009. As set forth in Applicant's application, the recitation of goods is for "cellular telephones, cellular phones housed in footwear, electronic game software for cellular telephones, people, objects, and pet locator and recovery device programmed to use global positioning systems (GPS) and cellular telephone communications". Of that list, Opposer was concerned solely with "electronic game software for cellular telephones"⁶

Thus, the sole issue in the Opposition related to the registration by Applicant of the "ID PHONE" mark for a type of goods, rather than the overall issue of the registration of the mark by Applicant.

Argument

The circumstances which led to the failure to timely answer the Notice of Opposition were beyond the control of undersigned, and they were responded to in a timely manner within the time period provided for in the TTAB's Order to Show Cause.

In that the Opposition to register Applicant's mark is solely based on Applicant's expressed intent to use the mark on "electronic game software for cellular telephones" in IC 009 (*See*, Notice of Opposition, ¶ 8), and in that Applicant has not used the mark in connection with any goods which would reasonably conflict with goods sold or marketed by Opposer, there has been no prejudice to the Opposer resulting from the minimal delay in filing an Answer to the Notice of Opposition, particularly since Applicant has an allowed application for the same mark

⁴ Before Hon. Tonianne Bongiovanni, in *William M. Gregg, II v. GI Apparel, Inc.*, Civil Action No. 3:06-cv-02367-GEB-TJB.

⁵ In fact, Applicant has received a Notice of Allowance for the same mark in IC 025, Ser. No. 77081408 for for footwear and shoes.

⁶ *See*, Notice of Opposition, at ¶ 8, in which Opposer expressly states. "Opposer opposes registration of ID PHONE for 'electronic game software for cellular telephones' but does not assert opposition as to sic] the other goods Applicant describes in his Application."

in IC 025 and since Opposer has affirmatively stated that it has no opposition to Applicant's registration of the mark in IC 009, but for the expressed recitation of one of the items of goods.

On the other hand, if the TTAB fails to vacate its Order, Applicant's entire application, including the registration of Applicant's "ID PHONE" mark on goods in IC 009 which are not objected to by Opposer, will be lost to the great detriment of Applicant.

CONCLUSION

In view of the foregoing, Applicant requests that this honorable TTAB recognize that the failure to timely file an answer resulted from an unusual set of circumstances, all of which have now been resolved⁷; that the slight delay caused no harm to Opposer; that the failure to discharge the Order to Show Cause and enter the accompanying Answer would cause great harm to the Applicant; that Applicant responded to both the Order and the need to file an Answer on the same day that the Interlocutory Attorney returned undersigned's phone call, all demonstrate that it would now be appropriate for the TTAB to discharge the Order to Show Cause, and enter the Answer, filed herewith.

Respectfully submitted,

Dated: November 14, 2007

By s/ Sanford J. Asman
Sanford J. Asman
Georgia Bar No. 026118
Attorney for Defendant-Applicant
Sayo Isaac Daniel

Law Office of Sanford J. Asman
570 Vinington Court
Atlanta, Georgia 30350

Phone : (770) 391-0215
Fax : (770) 668-9144
E-mail : sandy@asman.com

⁷ Namely, multiple court hearings, trials, and emergency motions in U.S. District Courts in three separate states, combined with a catastrophic computer system failure, and the illness of the Interlocutory Attorney.

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

ID SOFTWARE, INC.,

Plaintiff-Opposer

v.

SAYO ISAAC DANIEL

Defendant-Applicant.

Opposition No. 91179259

ANSWER

COMES NOW, Sayo Isaac Daniel, Defendant-Applicant (“Applicant”), and by way of answer to the Notice of Opposition of Plaintiff-Opposer Id Software, Inc. (“Opposer”) responds to the numbered allegations, as follows:

1. The allegations of paragraph 1 are admitted.
2. The allegations of paragraph 2 are admitted.
3. Paragraph 3 contains multiple allegations. The allegation of paragraph 3 as to the registration and ownership of U.S. Reg. No. 2165125 for the mark “ID” (“the ID mark”) is admitted. Applicant is without sufficient information to form a belief as to the remaining allegations of paragraph 3, whereby those allegations are denied.
4. The allegations of paragraph 4 are admitted.
5. The allegations of paragraph 5 are admitted.
6. Paragraph 6 contains multiple allegations. Applicant admits that the registration of “the ID mark” appears, of record, to remain in full force. Applicant is without sufficient

information to form a belief as to the remaining allegations of paragraph 6, whereby those allegations are denied.

7. Applicant is without sufficient information to form a belief as to the allegations of paragraph 7, whereby those allegations are denied.

8. The allegations of paragraph 8 are admitted.

9. Paragraph 9 contains multiple allegations. Applicant admits that he intends to use the mark “ID PHONE” to identify goods, namely “electronic game software for cellular telephones”, but Applicant denies the remaining allegations of paragraph 9.

10. The allegations of paragraph 10 are denied.

11. Applicant responds to paragraph 11, as set forth above.

12. Paragraph 12 contains multiple allegations. Applicant admits that “the ID Mark” was registered prior to the filing of Applicant’s application to register the mark “ID PHONE”, but Applicant denies the remaining allegations of paragraph 12.

13. Applicant responds to paragraph 13, as set forth above.

14. The allegations of paragraph 14 are denied.

15. Paragraph 15 contains multiple allegations. Applicant admits that he intends to use the mark “ID PHONE”, in connection with electronic game software for cellular phones, but Applicant denies the remaining allegations of paragraph 15.

16. The allegations of paragraph 16 are denied.

17. The allegations of paragraph 17 are denied.

CONCLUSION

WHEREFORE, Applicant that this honorable TTAB will now dismiss the present
Opposition.

Respectfully submitted,

Dated: November 14, 2007

By s/ Sanford J. Asman
Sanford J. Asman
Georgia Bar No. 026118
Attorney for Defendant-Applicant
Sayo Isaac Daniel

Law Office of Sanford J. Asman
570 Vinington Court
Atlanta, Georgia 30350

Phone : (770) 391-0215
Fax : (770) 668-9144
E-mail : sandy@asman.com

CERTIFICATE OF SERVICE

I certify that on the date set forth below, I electronically filed Defendant-Applicant's:

MOTION TO DISCHARGE ORDER TO SHOW CAUSE

ANSWER

using the ESTTA system, and that I also mailed a copy, by First Class Mail, with adequate postage affixed, to:

D. Wade Cloud, Jr., Esq.
Hiersche, Hayward, Drakeley & Urbach, P.C.
15303 Dallas Parkway, Suite 700
Addison, TX 75001

Respectfully submitted,

Dated: November 14, 2007

By s/ Sanford J. Asman
Sanford J. Asman
Georgia Bar No. 026118
Attorney for Defendant-Applicant
Sayo Isaac Daniel

Law Office of Sanford J. Asman
570 Vinington Court
Atlanta, Georgia 30350

Phone : (770) 391-0215
Fax : (770) 668-9144
E-mail : sandy@asman.com